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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,957	07/14/2003	Mitsushi Yamamoto	UNI79.013AUS	6418

  

20995	7590	10/15/2007
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EXAMINER	
AHMAD, NASSER	

  

ART UNIT	PAPER NUMBER
1794	

  

NOTIFICATION DATE	DELIVERY MODE
10/15/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
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<b>Office Action Summary</b>	Application No. 10/618,957	Applicant(s) YAMAMOTO ET AL.	
	Examiner Nasser Ahmad	Art Unit 1794	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 8 and 10-14 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8, 10-12 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>28/8/07, 5/16/07</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Rejections Withdrawn***

1. Claims 8 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Australian AU 9640808A made in the Office Action of 5/8/2007 has been withdrawn in view of the amendment filed on 8/8/2007.
2. Claims 8 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Malhotra (5534374) made in the Office Action of 5/8/2007 has been withdrawn in view of the amendment filed on 8/8/2007.
3. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Australian AU'808 or Malhotra made in the Office Action of 5/8/2007 has been withdrawn in view of the amendment filed on 8/8/2007.

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 8, 10-12 and new claim 14 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 8, 10-12, 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Masuda (US 20020064650A1).

Masuda relates to a transparent surface protective film (paragraph-[0001] recites that the film is for protecting windows and is transparent because the visible light transmittance is 3-70% as mentioned in paragraph-[0019]) a transparent polyester film (paragraph-[0019]), a transparent adhesive (paragraph-[0044]) coating on one side of the film (the adhesive is deemed to be transparent because the film protects transparent windows), and an antistatic layer is formed on at least the other side of the film (abstract and paragraphs-[0031] and [0032]). The antistatic layer comprises polymers having pyrrolidinium rings as repeating units in the main chain thereof (paragraph-0034] teaches that the pyrrolidinium rings are in the backbone of the polymer and hence, will have repeating units).

The reference mentions that the laminate exhibits excellent antistatic properties. It is also understood by the examiner that the polyester film is well known to be transparent, acrylate adhesive is known in the art as being transparent and the antistatic layer is also transparent, as is admitted in the instant application.

Further, the laminate would inherently exhibit the maintaining of transparency even after one-hour heat treatment at 150 degrees C.

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The intended use phrases such as "for transparent conductive substrates", etc. have not been given any patentable weight because said phrases are not found to be of positive limitations.

For claims 10-11, the thickness of the adhesive layer is 15 microns (paragraph-[0099]) which reads on the claimed range of 3-100 microns or 5-40 microns.

As for claim 12, the base material comprises polyethylene terephthalate, etc. (paragraph-0017)).

Regarding claim 14, the entirety of the film is transparent as it used with window application.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masuda

Masuda, as discussed above, discloses that the adhesive thickness is 15 micron (an example) but can be of any thickness. However, Masuda fails to teach that the thickness of the adhesive layer is 3-10 microns or 5-40 microns. It would have been obvious to one having ordinary skill in the art to modify the Masuda reference by

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providing the adhesive thickness to be 3-100 microns, based on optimization through routine experimentation, for optimum adhesiveness.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Nasser Ahmad  
Primary Examiner  
Art Unit 1794  
10/10/07

N. Ahmad.  
October 10, 2007.